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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,770	07/21/2003	Philip Lim-Kong Wong	029014.44732C1	4226

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EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3766

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/622,770

Applicant(s)

WONG ET AL.

Examiner

Frances P. Oropeza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/21/03 (Initial Filing).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/21/03.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Confusion with Serial Number***

1. The Request for Filing a Patent Application submitted 7/21/03 indicates the pending prior application is 09/834832. This number is incorrect. The pending prior application is indicated as 09/843892 on the Bib Date Sheet. This number is also incorrect. The correct number is believed to be 09/834892. Appropriate correction is required.

### ***Priority***

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be

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submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required.

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Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakumoto et al. (US 6449583) in view of Sham et al. (US 5661398).

Sakumoto et al. disclose a portable measurement apparatus for directly measuring time, distance and pulse rate (col. 2 @ 12-28 and col. 8 @ 45-50). Lap time/split time are measured using a lap button (col. 4 @ 29-35; col. 5 @ 44-50; col. 8 @ 2-3) requiring user intervention

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(col. 5 @ 25-32). A display section (104) on the device is used to view the data

(col. 4 @ 20-28).

Sakumoto discloses the claimed invention except for the lap sensing device outputting a first signal.

Sham et al. disclose a lap sensing device and teach that it is known to use two magnetic field sensors to automatically count laps by monitoring bearings readings and providing an output signal (col. 2 @ 12-19). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the a portable measurement apparatus as taught by Sakumoto et al., with the lap sensing device as taught by Sham et al. to provide an apparatus that automatically senses and monitors laps and lap preformance so the athlete can focus on the fitness activity and not be concerned with measuring the laps.

As to distance traveled, Sham et al. (US 5661398) discloses the microprocessor (19) can provide the total distance traveled (col. 6 @ 3-6).

As to time traveled, Sham et al. (US 5661398) discloses the microprocessor (19) can provide the total elapsed time (col. @ 3-6).

As to distance and time of the laps, Sham et al. (US 5661398) discloses the microprocessor (19) can provide the split time indicating the distance / time relationship (col. 6 @ 3-6).

As to the lap signal being continuous, Sham et al. (US 5661398) disclose the lap counting device can continuously output a signal indicating the completion of a lap or portion thereof (col. 2 @ 14-19; col. 5 @ 66 – col. 6 @ 2).

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5. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakumoto et al. (US 6449583) in view of Sham et al. (US 5661398) and further in view of Sham et al. (US 5891042). As discussed in paragraph 4 of this action, modified Sakamoto et al. disclose a measurement apparatus using a Global Positioning System, as an example, (col. 8 @ 46-50), to measure speed and distance, but also allow for alternate speed and distance measuring mechanisms (col. 9 @ 37-50). Sakamoto et al. disclose the claimed invention except for the motion sensor being a step sensor with a piezoelectric sensor.

Sham et al. (US 5891042) disclose a fitness monitoring device and teaches the use of a step sensor with a piezoelectric sensor to measure distance. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified portable measurement apparatus as taught by Sakumoto et al., with the step sensor with a piezoelectric sensor as taught by Sham et al. (US 5891042) to provide a convenient means for monitoring movement not using a Global Positioning System so a reliable fitness monitoring system is provided to the athlete to monitor his/her athletic performance (col. 1 @ 32-35).

6. Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakumoto et al. (US 6449583) in view of Sham et al. (US 5661398) and further in view of Kuehn et al. (US 4037328). As discussed in paragraph 4 of this action, modified Sakamoto et al. disclose the claimed invention except for the motion sensor being a swim stroke sensor with a Hall-effect sensor to monitor movement and a voltage controlled oscillator to determine the direction of movement.

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Kuehn et al. (US 4037328) disclose a spatial orientation device and teaches the use of a swim stroke sensor with a Hall-effect sensor to determine movement and a voltage controlled oscillator to determine the direction of movement (col. 3 @ 31-34 and col. 4 @ 47-52). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the modified portable measurement apparatus as taught by Sakumoto et al., with a swim stroke sensor with a Hall-effect sensor and a voltage controlled oscillator as taught by Kuehn et al. to provide a means to monitor movement and direction in the water when the fitness monitoring system is used to monitor the athlete's performance and the fitness activity is swimming.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Frances P. Oropeza  
Patent Examiner  
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FRP  
3/19/06

  
Robert E. Pezzuto  
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